

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 35-40, 42-48, 51, 53, 55-57, 59-62, 64-66, and 74-80 are pending in the application.

Claim Objections and 35 U.S.C. § 112 Rejections

Claims 59-62 and 64-66 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter set forth therein. The antecedent basis issue in claim 64 identified in the Office Action has been addressed in this Amendment, and Applicant accordingly requests the Examiner to reconsider and withdraw this rejection.

Allowable Subject Matter

Applicant notes with appreciation the indication on page 17 of the Office Action that claims 35, 43-47, 51, and 76-80 are allowed.

Statement of the Substance of the Interview

At the outset, Applicant's representative thanks the Examiner for the courtesies extended during the interview conducted on February 6, 2009. Applicant's representative and the Examiner discussed whether the rejections as presented in the outstanding Office Action were properly laid out, but no action was taken.

Claim Rejections under 35 U.S.C. §102(e) – *Watanabe*

Claims 59-62 and 64-66 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,285,662 to Watanabe et al. (hereinafter "Watanabe"). Applicants respectfully traverse this rejection, as detailed below.

MPEP §2131 sets forth the standard for a Section 102 rejection:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *MPEP §2131 (quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id. (quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

In addition, "the reference must be enabling and describe the Applicant's invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The 35 U.S.C. § 102(e) anticipation rejection of claims 59-62 and 64-66 is improper because the rejection does not meet all of the above criteria for the reasons and explanations set forth below.

Watanabe generally discusses "an apparatus, and associated method, by which to incrementally alter the size of a contention window, used by a sending station operable in such a system, to send a packet of data within the boundaries defined by the contention window" (col. 1, lines 11-15).

In the rejection, the Examiner points to col. 9, lines 12-26 of Watanabe as disclosing "the processor is further configured to randomly select an uplink access slot to be used for transmitting a preamble of said random access message from the allowed access slots of the physically existing random access channel" recited in independent claim 64. This portion of Watanabe states:

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FIG. 3 illustrates several sequentially positioned MAC frames 72, each having a number of random access channels 16. Contention windows are selected during operation of an embodiment of the present invention and packet data is caused to be transmitted upon various of the channels within the boundaries of the contention windows. For an initial transmission attempt, $a=0$, wherein a is the attempt number, determination is made as to the number of random access channels which are available within a frame. For instance when n random access channels are contained within an initial frame, a packet of data can be caused to be transmitted upon one of the available random access channels. If, for example, only one random access channel is available in the frame, the packet is caused to be transmitted upon the available channel. (Watanabe, col. 9, lines 12-26; emphasis added.)

The Examiner alleges that this portion of Watanabe teaches “wherein the frame transmitting on uplink access slot inherently having preamble.” (Office action, pg. 5.) Even if the Examiner is correct about each frame having a preamble, there is no discussion in the cited portion of Watanabe about randomly selecting an access slot. Here, Watanabe simply discloses that packet data is sent on a selected channel within a frame. The term “various” highlighted above does not mean “random” as in the claimed invention, but simply that “multiple” channels are used. Likewise, the term “random” access channel simply refers to a shared channel in which messages are not scheduled, which is unrelated to the method of selecting the channel.

The Examiner also points to col. 3, line 66, through column 4, line 9 of Watanabe in rejecting “wherein consecutive preambles are transmitted a predetermined number of access slots apart” recited in independent claim 64. This portion of Watanabe states:

[T]he sending station transmits packets of data upon selected time slots defining random access channels of a MAC (medium access control) frame in which time slots are dynamically allocated on a frame-by-frame basis. In a TDD (time-division duplex) system, an indication of the number of time slots allocated to form random access channels in that frame is broadcast to the sending station. At least selectably responsive to the number of time slots allocated to form random access channels in the frame, a determination is made as to the size of the contention window. (Watanabe, col. 3, line 66, through column 4, line 9.)

In view of this portion of Watanabe disclosing “time slots [that] are dynamically allocated,” the Examiner alleges “thus their preambles would have been selectively transmitted

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corresponding to the dynamical allocation of the selected slots.” (Office action, pg. 5.) Again here, however, the term “dynamically allocating” does not mean randomly selecting, but simply that the time slots are allocated at run-time and not in a predetermined manner. Further, even if the Examiner is correct in that the preambles are selectively transmitted corresponding to the dynamic allocation, there is no mention of the spacing between preambles or a requirement that the spacing be restricted to a predetermined number of access slots as claimed.

In short, there is simply no indication in Watanabe that the disclosed frames are randomly selected for transmission, or that a predetermined separation is maintained between successive frame preambles. The rejection fails to specifically address these issues and therefore to provide a showing in Watanabe of “each and every element as set forth in the claim,” which is required for a proper anticipation rejection under 35 U.S.C. § 102(e).

Independent claim 64 is thus allowable for the reasons given above. Further, the dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

Claim Rejections under 35 U.S.C. § 103(a) – *Watanabe in view of Gustafsson*

Claims 36-42, 48, 53, 55-57, and 74-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of U.S. Patent 6,836,469 to Gustafsson et al. (hereinafter “Gustafsson”). Applicants respectfully traverse this rejection, as detailed below.

The present application is a continuation of application no. PCT/EP99/03630, filed on May 26, 1999, and originally assigned to Nokia, Corp. as evidenced by Reel 012613 and Frame 0619. The reference Watanabe, filed 12 days earlier on May 14, 1999, was also assigned to Nokia, Corp. as evidenced by Reel 010251 and Frame 0894. Accordingly, Applicant notes that

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Watanabe, which qualifies as prior art only under § 102(e), and the present application were both commonly owned or subject to an obligation of assignment to Nokia, Corp. at the time that each of the inventions were made. Therefore, 35 U.S.C. § 103(c)(1) precludes the Examiner from using Watanabe in a 35 U.S.C. § 103 rejection.

Applicant respectfully requests that the Examiner withdraw this art grounds of rejection.

CONCLUSION

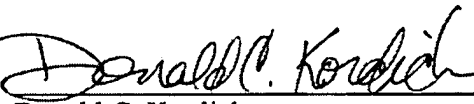
In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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